

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant : Kenji ABIKO

Group Art Unit: AU 1742

Appeal No. 2004-1362

Examiner: Wilkins

Application No.: 09/926,600

Adm. Patent Judges: E. Kimlin; C Timm; J. Smith

Filed: November 26, 2001

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U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCESFor: **Cr-BASED ALLOY HAVING AN EXCELLENT STRENGTH-  
DUCTILITY BALANCE AT HIGH TEMPERATURES****REQUEST FOR REHEARING UNDER 37 C.F.R. 1.197(b)  
OF THE DECISION OF SEPTEMBER 29, 2004**Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions set forth in 37 CFR §1.197(b), Appellant respectfully requests that the Decision of the Board of Patent Appeals and Interferences ("the Board"), mailed September 29, 2004, be reconsidered and modified, in view of certain particularly identified points which appear to have been either misapprehended or overlooked, as explained below.

**A. Decision of the Board**

In the decision, the Board affirmed the rejection under 35 U.S.C. §103(a) of claims 1, 3, and 4 over EP 0597129 ("Fujisawa") and reversed the rejection under 35 U.S.C.

§103(a) of claims 1-6 over the combined teachings of JP 07-278718 ("Shida") and JP 08-225899 ("Abiko").

Claim 1 is directed to a Cr-based alloy having a Cr content exceeding 60 mass% and a combined C + N content of not more than 20 mass %. Fujisawa discloses a Cr-based alloy with a Cr content up to 60% and does not disclose a content of Cr exceeding 60 wt%. In affirming the rejection of claims 1, 3, and 4 under 35 U.S.C. §103(a) over Fujisawa, the Decision states that "a person of ordinary skill in the art would have reasonably expected that an alloy having a Cr content slightly above 60 wt% would perform as disclosed by Fujisawa." Although the Decision recognizes Appellant's arguments that Fujisawa teaches away from a Cr content in excess of 60 wt%, the Decision does not address why the "teaching away" of Fujisawa is not a significant factor in the failure to establish a *prima facie* case of obviousness. The Decision states that "Appellant has not directed us to evidence that minor increases in the amount of Cr above 60 wt%, such as identified by the Examiner, would have resulted in poor workability and insufficient improvement in the acid resistance." (Page 6 of the Decision.)

**B. Request for Rehearing**

While Appellant appreciates the Board's reversal of the rejection of claims 1-6 over the combined teachings of Shida and Abiko, in this Request for Rehearing, Appellant respectfully requests Board to reconsider the decision to affirm the rejection

under 35 U.S.C. §103(a) of claims 1, 3, and 4 over Fujisawa. Specifically, Appellant respectfully submits that the Board has misapprehended or overlooked the argument that Fujisawa teaches away from the claims 1, 3, and 4 of the present application and requests that Board reconsider Appellant's arguments that Fujisawa teaches away from the claimed invention; specifically, the recitation of claim 1 of an alloy with Cr "exceeding 60 mass %."

Appellant notes that, in this Request for Rehearing, no new arguments or evidence are presented.

Appellant respectfully submits that the portion of Fujisawa that teaches away from the claimed invention should be considered as a significant factor in determining whether a *prima facie* case of obviousness has been established. Because Fujisawa teaches away from an alloy with a Cr content exceeding 60%, one of ordinary skill in the art at the time of the invention would not have been motivated to modify the alloy of Fujisawa such that the Cr content exceeds 60%. If anything, one would be lead away from an alloy with a Cr content exceeding 60%.

Fujisawa discloses an alloy with a Cr content "up to 60%." There is no overlap between Fujisawa's "up to 60%" and the claimed "exceeding 60 mass%." Fujisawa discloses that when Cr exceeds 60%, it will a) result in insufficient workability or induce a decrease in workability; b) not contribute to further improvement in acid resistance; and c) increase cost. The preferred range of Fujisawa is actually much lower

than “up to 60%” (for instance 5-30% as disclosed at page 10, line 46 of Fujisawa). In all of the examples of Fujisawa, when C, N, S, O are low in amount (as required in claim 1 of the present invention), Cr contents are also much lower than 60%. Therefore, Fujisawa does not teach or suggest a higher Cr content (over 60%) in combination with the low amounts of C, N, S, and O. Appellant respectfully submits that Fujisawa should be considered “as a whole” and because it leads away from the claimed value, a *prima facie* case of obviousness has not been established. In other words, one of ordinary skill in the art, reading Fujisawa as a whole, would not have been motivated to arrive at an alloy with a Cr content exceeding 60%.

Regarding the assertion in the Decision that Appellant has not provided evidence that minor increases in the amount of Cr above 60 wt%, such as identified by the Examiner, would have resulted in poor workability and insufficient improvement in the acid resistance, Appellant respectfully submits that this improperly places the burden of going forward with production of evidence on Appellant. The Examiner bears the initial burden of factually supporting any *prima facie* case of obviousness. If the Examiner does not establish a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness. M.P.E.P. §2142. In the present application, the Examiner has failed to establish a *prima facie* case of obviousness because Fujisawa would actually lead one of ordinary skill in the art away from the claimed invention of an alloy with a Cr content exceeding 60 mass%. The burden should not be shifted to

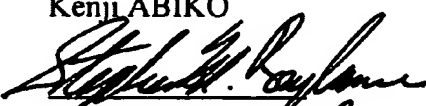
Appellant to produce evidence in the absence of a *prima facie* case of obviousness.

For above reasons, reconsideration of the affirmation of the rejection of claims 1, 3, and 4 is respectfully requested. In this regard, the Board is respectfully urged to consider and address the "teaching away" aspects of Fujisawa.

C. Conclusion

For the reasons expressed above, appellant requests that the Board reconsider its decision and render a decision on the merits of the appeal to reverse the rejections under 35 USC §103 of claims 1, 3, and 4 for reasons advanced above as well as those that are presented by Appellant in his brief, reply brief, and oral argument of August 17, 2004.

Respectfully submitted,  
Kenji ABIKO

  
Bruce H. Bernstein  
Reg. No. 29,027

Reg. No. 31,296

November 29, 2004  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191